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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,847	04/21/2004	Mary Teresa Murphy	2550.0001	5357

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KEVIN J. MCNEELY, ESQ.
5335 WISCONSON AVENUE, NW
SUITE 440
WASHINGTON, DC 20015

EXAMINER

HOGUE, GARY CHAPMAN

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/828,847	Applicant(s) MURPHY, MARY TERESA	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 17-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on October 27, 2005.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the symbol on the identifier tab (claim 3) and the identifier tab being semi-circular (claim 4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation that the insertion card is rectangular conflicts with the recitation in claim 1 that the insertion card is circular.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Milliorn et al. (2003/0039786).

Claim 1 is drawn to the subcombination of the label. Therefore, all recitation regarding a media disk storage device is merely a statement of intended use and does not define over the prior art. Milliorn discloses a circular card **18** having an identifier tab **16**.

Regarding claim 2, the identifier tab comprises a printable surface.

Regarding claim 3, it has been held that although printed matter must be considered, where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ

Art Unit: 3611

401. In this case, there is no functional relationship between the printed matter and the substrate. Rather, the relationship of the substrate to the printed matter is merely that of support and display.

Regarding claim 6, see Fig. 3.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milliorn et al. (2003/0039786).

The identifier tab shown in Fig. 1 is semi-circular in shape. However, Milliorn also discloses using an identifier that is rectangular in shape (see Fig. 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use either shape as an obvious matter of choice in design.

8. Claims 9 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandry (5,826,717) in view of Warden (5,724,757) and Balzer (2003/0010815).

Eskandry discloses a media disk organizer having at least three pockets moveably attached to a binder in a stacked arrangement. However, Eskandry does not disclose a label having a circular insert portion and a tab. Warden teaches that it was known in the art to provide a label for insertion into a pocket that holds a CD. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pockets disclosed by

Art Unit: 3611

Eskandry with identification labels, as taught by Warden, in order to identify the CDs stored in the disk organizer. Further, the shape of the label disclosed by Warden corresponds to the shape of the pocket disclosed by Warden. Because the pockets disclosed by Eskandry are circular, it would be necessary to make the labels circular in order to fit those pockets, and it would have been obvious to one having ordinary skill in the art at the time the invention was made to make them circular for that reason. Finally, Balzer illustrates the commonly-known practice of staggering index tabs between left, center and right. It would have been obvious to one having ordinary skill in the art at the time the invention was made to stagger the index tabs in the pockets disclosed by Eskandry, as taught by Balzer, in order to make the tabs easier to see.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandry (5,826,717) in view of Warden (5,724,757) and Balzer (2003/0010815) as applied to claim 9 above, and further in view of Minter (5,295,577).

Eskandry, as modified, discloses the invention substantially as claimed, as set forth above. However, there is no master index identifying the disks in the organizer. Minter teaches that it was known to provide such an index (see index 450). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the organizer disclosed by Eskandry with a master index, as taught by Minter, in order to see at a glance which disks are stored in the organizer.

10. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandry (5,826,717) in view of Warden (5,724,757) and Balzer (2003/0010815) as applied to claim 9 above, and further in view of Dulin (5,076,490).

Art Unit: 3611

Eskandry, as modified, discloses the invention substantially as claimed, as set forth above. However, it is not known how the labels are produced. Dulin teaches that it was known in the art to produce multiple labels from a single perforated sheet (see Fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to produce the labels disclosed by Eskandry, as modified, on a single perforated sheet, as taught by Dulin, in order to save both time and paper.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandry (5,826,717) in view of Warden (5,724,757) and Balzer (2003/0010815) as applied to claim 13 above, and further in view of Liedtke (6,271,932).

Eskandry, as modified, discloses the invention substantially as claimed, as set forth above. However, Eskandry does not disclose providing a computer to print identifiers on the labels. Liedtke teaches that it was known in the art to provide a computer program to instruct a computer system having a printer to print an identifier on a label. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a computer program to print identifiers on the labels disclosed by Eskandry, as modified, as taught by Liedtke, in order to automate the process and make the identifiers look neater than if they were hand-written.

Response to Arguments

12. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

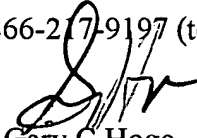
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge
Primary Examiner
Art Unit 3611

gch